



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2021-0042]

Extension of the Motion to Amend Pilot Program in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is extending the Motion to Amend (MTA) Pilot Program, which was initiated on March 15, 2019, and provides additional options for a patent owner who files an MTA before the Patent Trial and Appeal Board (PTAB). In particular, the MTA Pilot Program provides a patent owner who files an MTA with options to request preliminary guidance from the PTAB on the MTA and to file a revised MTA. The program also provides timelines for briefing to accommodate these options.

DATES: *Effective Date:* [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER]. *Duration:* The MTA Pilot Program will run until [INSERT DATE ONE YEAR AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER]. The USPTO may extend the MTA Pilot Program (with or without modification) on either a temporary or a permanent basis, or may discontinue the program after that date.

FOR FURTHER INFORMATION CONTACT: Jessica Kaiser, Lead Administrative Patent Judge, or Michelle Ankenbrand, Lead Administrative Patent Judge, by telephone at 571-272-9797.

SUPPLEMENTARY INFORMATION:

A patent owner in an America Invents Act (AIA) trial proceeding may file an MTA as a matter of right. *See* 35 U.S.C. 316(d)(1), 326(d)(1). After receiving feedback from the

public about the PTAB's MTA practice, including some concerns regarding the grant rate of claim amendments in AIA trial proceedings, in October 2018 the USPTO published a Request for Comments in the Federal Register seeking written public comments on a proposed amendment process in AIA trials that would involve preliminary guidance from the PTAB on the merits of an MTA and an opportunity for a patent owner to file a revised MTA (Request for Comments on Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 83 FR 54319 (Oct. 29, 2018)). The majority of comments supported the PTAB issuing a preliminary decision in cases involving an MTA, and commenters were almost evenly mixed in supporting or opposing a revised MTA. On March 15, 2019, in response to the stakeholder comments received, the USPTO issued a notice detailing the MTA Pilot Program (Notice Regarding a New Pilot Program Concerning Motion To Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 FR 9497 (Mar. 15, 2019)).

The MTA Pilot Program provides a patent owner with two options not previously available: (1) A patent owner may choose to receive preliminary guidance from the PTAB on its MTA, and/or (2) A patent owner may choose to file a revised MTA after receiving the petitioner's opposition to the original MTA and/or after receiving the PTAB's preliminary guidance (if requested). If a patent owner does not elect either the option to receive preliminary guidance or the option to file a revised MTA, AIA trial practice, including MTA practice, is essentially unchanged from the practice prior to the MTA Pilot Program.

The USPTO has presented preliminary results of the MTA Pilot Program and continues to track data related to MTAs. The most recent information and statistics related to MTAs are available on the USPTO's website at www.uspto.gov/patents/ptab/motions-amend-study.

Based on the preliminary results of the MTA Pilot Program, the USPTO has decided to extend it. The program is hereby extended through [INSERT DATE ONE YEAR AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER]. The USPTO may extend the MTA Pilot Program (with or without modification) on either a temporary or a permanent basis, or may discontinue the program after that date.

The requirements for the MTA Pilot Program remain as set forth in the original notice, without modification at this time.

Andrew Hirshfeld,

Commissioner for Patents, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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